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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,149	08/30/2001	Maria Azua Himmel	AUS920010454US1	6541

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,149

Applicant(s)

HIMMEL ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on April 16, 2004. Claims 1-22 are pending. Claims 1-3, 6-9, 12-15 and 18 have been amended. Claims 19-22 have been added.

Claim Objections

2. Claim 20 is objected to because of the following informalities: claim 20 should dependent on claim 19, not dependent on claim 20 itself. Appropriate correction is required.

Response to Arguments

3. Applicant's arguments filed April 16, 2004 have been fully considered but they are not persuasive.

Applicant argues that Moen (U. S. Patent 5,864,604) fails to teach the party associated with the requested document is charged, in lieu of the client who otherwise charged for their network access, for subsequent access to the network by the client. Examiner believes that Moen teaches this limitation by charging the sponsor or the owner of the website instead of charging the client for the network access by the client (column 4 line 63 – column 5 line 15).

In response to applicant's arguments for claims 2, 6, 8, 12, 14 and 18 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

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only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-5, 7, 9-11, 13, 15-17 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Moen et al., U. S. Patent 5,864,604.

As to claims 1, 7, 13 and 19, Moen teaches a method of billing intervention for network charges associated with access to a network, a computer program in a computer-readable medium, and a data processing system, comprising (abstract):

- a) Receiving from a client via the network a request for a document (abstract and column 6 lines 14-28 and column 7 lines 58-61; *specifically, "a request for a document" corresponds to the process to gain the access of the predetermined message in Moen's teaching*);
- b) In response to receiving the request, charging a party associated with the document, in lieu of the client who otherwise is charged network charges for their network access, for subsequent access to the network by the client (column 4

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line 63 – column 5 line 15; *specifically, “a party” corresponds to the sponsor in Moen’s teaching*);

c) A bus system, a processing unit connected to the bus system and including at least one processor, memory connected to the bus system, and a set of instructions in the memory, wherein the processor unit executes the set of the instructions to perform the steps above (column 50 lines 50-62; *specifically, these limitations for the bus system, the processing unit, the memory correspond to the telecommunication network system in Moen’s teaching*).

As to claims 3, 9, 15 and 20, Moen teaches the client is a mobile computer and client access to the network is via a wireless link and the network charges are associated with the wireless link access to the network (column 5 lines 31-37).

As to claims 4, 10 and 16, Moen teaches the mobile computer a portable digital assistant (column 5 lines 31-37).

As to claims 5, 11 and 17, Moen teaches the mobile computer is within a mobile telephone (column 5 lines 31-46).

As to claim 21, Moen teaches a method for network access billing intervention in a system comprising a sender, receiver and intervener coupled together via a network, comprising the steps of (abstract): monitoring network traffic of the sender by the intervener (abstract); and responsive to a determination that the sender is sending a request for information associated with the receiver, changing network access billing of the sender to instead bill the receiver for the sender’s network access (column 4 line 63 – column 5 line 15).

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As to claim 22, Moen teaches the sender sends the request via a wireless link using a wireless communication device and the network access charges are associated with the wireless link access to the network (column 5 lines 31-37).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2, 6, 8, 12, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moen et al., U. S. Patent 5,864,604 in view of Suzuki, U. S. Patent 6,493,763.

As to claims 2, 8 and 14, Moen teaches a method, a computer program, and a data system for billing intervention for access a network as discussed in claims 1, 7 and 13 above. Moen further teaches automatically accounting for access to web documents

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by the plurality of clients in a plurality of parties, and in response to receiving a second request for a second web document, the web document is provided to the client, an appropriate amount is charged to a corresponding party (column 4 line 63 – column 5 line 15 and column 6 lines 14-28 and column 9 lines 5-14; *specifically, the web documents correspond to the predetermined messages in column 7 lines 55-65*).

Moen does not specifically teach in response to receiving a second request for a second web document that is not associated with the party, discontinuing charging the party for the subsequent network activity of the client. However, Suzuki teaches in response to a client service request for an information that is not associated with the sponsor party, discontinuing charging the sponsor party for the network activity of the client, and charging the client's account instead (column 5 lines 20-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Moen's teaching to include the feature of discontinuing charge the party for the network activity of the client if the web document requested by the client is not associated with the party because this would result a fair and accurate accounting for both of the client and the party as enunciated by Suzuki (column 3 lines 6-11).

As to claims 6, 12 and 18, Moen teaches an appropriate amount is charged to the corresponding party based on the network activity of the client, and the measuring of the network activity comprising a pre-determined time interval, time of access and duration of access; and during the access, the allotted credit is decremented (column 4 line 63 – column 5 line 15 and column 6 lines 14-25, 58-60 and column 9 lines 15-21; *specifically, "a pre-determined time interval" corresponding to the preset time period in*

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column 6 lines 58-60). Moen does not specifically teach after a pre-determined time interval has elapsed, discontinuing charging the party for the subsequent network charges associated with subsequent access to the network by the client. However, this matter is taught by Suzuki as discontinuing charge the sponsor party if the sponsor party is not responsible for network activity of the client (column 5 lines 20-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Moen's teaching to include the feature of discontinuing charge the sponsor party for the network activity of the client if the pre-determined time interval has elapsed because this would result a fair and accurate accounting for both of the client and the sponsor party as enunciated by Suzuki (column 3 lines 6-11).

Conclusion

9. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

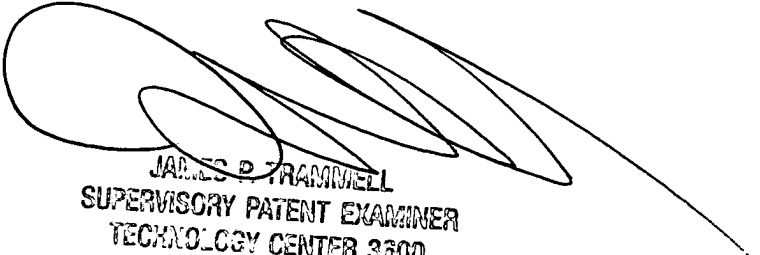
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")
(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
August 6, 2004


JAMES P. TRAMMELL
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